REMARKS

This is a response to a restriction requirement in the Office Action dated 11 MAY 1998. The Office Action restricted the application into the following eight separate inventions:

I. Claims 1-5, and 12, directed generally to a protein, a fusion protein, and a composition, classified in class 530, subclass 350; class 424, subclass 185.1; class 514, subclass 21.

II. Claims 6, 7, and 12, directed generally to an antibody, classified in class 530, subclass 387.9.

III. Claim 8, directed generally to a method of purifying a protein, classified in class 530, subclass 413.

IV. Claims 9-11, 12, 17, 19, and 20, directed generally to a nucleic acid, vector, and a method of expressing a protein, classified in class 536, subclass 23.5; class 435, subclasses 69.1 and 320.1.

V. Claim 13, directed generally to a method of detecting a protein, classified in class 435, subclass 4.

VI. Claims 14-16, directed generally to a method of modulating a cell, classified in class 435, subclasses 69.1, 375, and 377.

VII. Claim 18, directed generally to a tissue, cell or organism, classified in class 435, subclasses 325 or 347, or class 800, subclass 2.

VIII. Claims 21, and 22, directed generally to a method of treating a mammal, classified in class 424, subclasses 139.1 or 185.1, or class 514, subclass 44.

Applicants provisionally elect, with traverse, Group IV (claims 9-12, 17, and 19-20), directed generally to a nucleic acid, vector, and methods of expressing a protein, classified in class 536, subclass 235; and class 435, subclass as 69.1 and 320.1.

Applicants understand that there are two criteria for a proper Restriction Requirement according to MPEP §803:

(1) the invention must be independent or distinct as claimed, and
(2) there must be a serious burden on the Examiner if the restriction is not required.

In particular,

"If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Also,

"Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement."

Applicants submit that the restriction response is improper because the claims are so closely related that they should remain in the same application to preserve unity of invention. Note that search of Class 530 would be required for groups I, II, and III; and search of class 435 would be required for groups IV, V, VI, and VII. Thus, there is considerable overlap in search. The claims of the invention are directed to what may be considered a single subject matter. Restriction must then be based upon their distinctness, as claimed. According to MPEP §802.01, this means that they are capable of separate manufacture, use or sale, and are patentable over each other. The Examiner has directed comments to the question of whether the inventions are independent and distinct.

The Examiner has concluded that a unified search would present a serious burden if restriction were not required. Applicants respectfully request reconsideration of that determination in view of the significant overlap of the search. Applicants therefore, respectfully request reconsideration and withdrawal of the Restriction Requirement.

Furthermore, according to MPEP §821.04,

"if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined."

The MPEP at §821.04 further instructs that,

"applicants are encouraged to present such process claims. . . in the application at an early stage of prosecution."

Accordingly, Applicants' intention is to additionally present claims directed to a method of making or using such, e.g., methods of detecting, kits, etc. Claims 9-11, 12c, 13, 14c, and 15-20 all refer to nucleic acid compositions.

Should the restriction be made final, Applicants will then address the issue of inventorship for the selected claims and amend inventorship accordingly, if appropriate.

Applicants believe that no fees are due, aside from the $110.00 for a one month extension of time. If, however, any additional fees are required by the present response, the Commissioner is authorized to charge any fees or credit any overpayment to DNAX Research Institute Deposit Account No. 04-1239.

Respectfully submitted,

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Enclosures and attachments:
Petition for a one month extension of time

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